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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,533	02/07/2002	Mark D. Michaud	12350.0010.NPUS00	1312
7590	06/15/2004		EXAMINER	
John D. Norris Howrey Simon Arnold & White, LLP 750 Bering Drive Houston, TX 77057-2198			NGUYEN, DUNG V	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,533

Applicant(s)

MICHAUD ET AL.

Examiner

Dung V Nguyen

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 28-35 and 42-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 9-26 and 37-41 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 8, 27 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 7, 9-26 and 37-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahlf (USPN 4,181,540). Ahlf discloses a process comprising providing a tool, introducing an active chemical onto a workpiece, the active chemistry being capable of reacting with the workpiece to form a conversion coating on the workpiece, the conversion coating being insoluble in the active chemistry such that the conversion coating protects the workpiece from further reaction, contacting the tool with the workpiece with a relative motion therebetween, until a desired surface property of the workpiece is reached, wherein the contact between the tool and the workpiece removes the conversion coating from the workpiece, thereby exposing the workpiece to further reaction with the active chemistry such that the conversion coating is allowed to reform on the workpiece, wherein the surface property of the workpiece is surface finishing, wherein the active chemistry is water-based, wherein the active chemistry comprises active ingredients of phosphate salts, chromates, wherein the active chemistry is introduced onto the workpiece with a diluent of water, wherein the workpiece is formed from a metal, wherein the conversion coating comprises a compound of phosphate of the metal and a chromate of the metal, wherein the metal is iron, wherein the relative

Art Unit: 3723

motion between the workpiece and the tool is caused by moving the tool across the workpiece, wherein the tool or the workpiece is stationary, wherein neither the tool nor the workpiece is stationary, wherein the tool is non-abrasive, low abrasive, rigid, flexible, a mating surface of the workpiece, wherein the tool is formed from a non-reactive material, a cloth, wherein the tool is reactive to the active chemistry, wherein the process is carried out at a temperature less than the thermal degradation temperature of the workpiece, wherein the tool is contacted with the workpiece at a force less than the plastic deformation, shear strength, tensile strength of the workpiece, and causes material to be removed from the workpiece less than 0.05 millimeters (note col. 2, line 15 to col. 4, line 21).

Allowable Subject Matter

3. Claims 5, 6, 8, 27 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment

4. The declaration under 37 CFR 1.132 filed 18 March 2004 is insufficient to overcome the rejection of claims 1-4, 7, 9-26 and 37-41 based upon 35 U.S.C. 102(b) as being anticipated by Ahlf as set forth in the last Office action because: facts presented are not germane to the rejection at issue.

5. It refers only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective

Art Unit: 3723

evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

6. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Response to Arguments

7. Applicant's arguments filed have been fully considered but they are not persuasive. In response to applicant's argument that Ahlf is inoperative and fails to teach one of ordinary skill in the art the invention disclosed therein, Ahlf clearly anticipates claims 1-4, 7, 9-26 and 37-41 as disclosed in col. 2, line 15 to col. 4, line 21.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

9. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

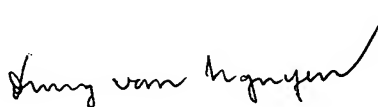
Art Unit: 3723

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung V Nguyen whose telephone number is 703-305-0036. The examiner can normally be reached on M-F, 6:30-3:00.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J Hail can be reached on 703-308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DVN
June 14, 2004



**DUNG VAN NGUYEN
PRIMARY EXAMINER**